

Remarks

Responsive to the Election Requirement mailed July 24, 2008, the Applicants elect, as the salt, the species benzyltrimethylammonium chloride. Applicants elect, as the alpha amino protecting group, Fmoc (9-fluorenylmethoxycarbonyl).

The examiner also required an identification of the claims encompassing the elected invention. The elected invention is encompassed by Claims 1-16.

The Office has asserted that the species lack unity of invention, because “the species lack the same or corresponding special technical features for the following reasons: There is an examination and search burden for the species due to their mutually exclusive characteristics. Each of the species are structurally distinct and one of skill in the art would not recognize that every alternative would behave in the same way. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to the other species.” The Applicants respectfully submit that this is an improper basis for asserting that the claims lack unity of invention. Pursuant to MPEP 1850,

Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT Article 33(6), by any additional document considered to be relevant. If the common matter of the independent claims is well known and the remaining subject matter of each claim differs from that of the others without there being any unifying novel inventive concept common to all, then clearly there is lack of unity of invention. If, on the other hand, there is a single general inventive concept that appears novel and involves inventive step, then there is unity of invention and an objection of lack of unity does not arise. For determining the action to be taken by the examiner between these two extremes, rigid rules cannot be given and each case should be considered on its merits, the benefit of any doubt being given to the applicant.

Furthermore, the Applicants have attached a copy of the International Preliminary Report on Patentability, dated January 9, 2006, for the underlying International application (PCT/EP2004/006512), showing that the International Searching Authority has already determined that there is unity of invention. Section 1850 of the MPEP continues,

From the preceding paragraphs it is clear that the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Examining Authority.

Therefore, the Applicants respectfully submit that the Office has not provided a valid basis for its assertion that there is lack of unity of invention. The Applicants respectfully request that the claims be fully examined as written.

The Applicants invite the Examiner to contact the Applicants' undersigned representative at (312) 913-3319 if the Examiner believes that this would expedite prosecution of this application.

Respectfully submitted,

Date: September 30, 2008

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